



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
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Alexandria, VA 22313-1450  
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Irvine, CA 92614

**MAILED**  
**FEB 29 2012**

**OFFICE OF PETITIONS**

In re Patent of Garrafa	:	
Patent No. 5,678,541	:	
Issue Date: October 21, 1997	:	Decision on Petition and
Application No. 08/616,223	:	Second Request for Information
Filing Date: March 5, 1996	:	
Attorney Docket No. Atomic-1	:	

The instant paper addresses the response to a prior Request for Information and the petition under 37 C.F.R. § 1.183 filed December 19, 2011.

**The Petition under 37 C.F.R. § 1.183**

The Office mailed a Request for Information on October 6, 2011. The request set a non-extendable period for reply of two months from the mailing date of the request. Petitioner requests waiver of the two-month time limit. The Office has determined justice supports waiver of the time limit and the petition under 37 C.F.R. § 1.183 is hereby **granted**.

**Second Request for Information**

This paper refers to the patents identified below as follows:

- |    |                           |              |
|----|---------------------------|--------------|
| 1. | U.S. Patent No. 5,678,541 | Atomic-1     |
| 2. | U.S. Patent No. 5,803,073 | Atomic-2     |
| 3. | U.S. Patent No. 6,098,924 | Non-Atomic-1 |
| 4. | U.S. Patent No. 6,347,766 | Non-Atomic-2 |
| 5. | U.S. Patent No. 6,463,640 | Atomic-10    |
| 6. | U.S. Patent No. 6,761,163 | Atomic-14    |

**Maintenances Fee Paid During 2000-2001**

Tachner paid the 3.5 year maintenance fee for Atomic-2 on September 21, 2000. The Office assumes Tachner sent an invoice for the fee to Petitioner.

Tachner paid the 3.5 year maintenance fee for Atomic-1, and sent Petitioner an invoice for the fee, on October 22, 2001.

#### Maintenance Fees Paid During 2002-2003

The record does not show that Tachner paid any maintenance fees on behalf of Petitioner during 2002 or 2003.

#### Maintenance and Annual Fees Paid During 2004

The petition refers to two EPO applications. The two applications appear to have issued as European Patent Nos. 0901400 ("E1") and ("E2") during 2003.<sup>1</sup> Tachner paid annual fees for E1 and E2 on April 7, 2004, and April 8, 2004. The Office assumes Tachner sent Petitioner one or more invoices for these fees.

Tachner paid the 3.5 year maintenance fee for Non-Atomic-1 on April 15, 2004. The Office assumes Tachner sent Petitioner an invoice for the fee.

Tachner paid the 7.5 year maintenance fee for Atomic-2 on July 9, 2004. The Office assumes Tachner sent Petitioner an invoice for the fee.

#### Maintenance and Annual Fees Paid Between January 1, 2005, and November 1, 2010

The Office is unaware of Tachner paying any maintenance fees or annual fees on behalf of Petitioner between January 1, 2005, and November 1, 2010.

E1 "lapsed" during 2005 as a result of the non-payment of annual fees due for E1.

E2 "lapsed" during 2005 as a result of the non-payment of annual fees due for E2.

Atomic-1 expired during 2005 as a result of the non-payment of the 7.5 year maintenance fee.

Non-Atomic-2 expired during 2006 as a result of the non-payment of the 3.5 year maintenance fee.

Atomic-10 expired during 2006 as a result of the non-payment of the 3.5 year maintenance fee.

Non-Atomic-1 expired during 2008 as a result of the non-payment of the 7.5 year maintenance fee.

Atomic-14 expired during 2008 as a result of the non-payment of the 3.5 year maintenance fee. The Office notes, if the 7.5 year maintenance fee had been timely paid for Atomic-1, the 11.5 year fee for the patent would have been due in 2009.

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<sup>1</sup> The information in this request pertaining to the European patents is based on information obtained from <http://www.epo.org/searching/free/espacenet.html>.

The Office notes, if the prior maintenance fees for Atomic-2, Non-Atomic-2, and Atomic-10 had been timely paid, a maintenance fee would have been due for each of these patents on dates prior to Petitioner inquiring into the status of the patents.

### Discussion

As recognized in the Response, “Even though a patentee may be able to show that its delay was caused by attorney deception, the patentee is still required to show that it acted reasonably and responsibly to keep the patent maintained.”<sup>2</sup>

Petitioner has not shown diligence in this matter since it appears that petitioner did not inquire into the status of Petitioner’s patents until more than six years and three months after receiving an invoice for a maintenance fee or annual fee from Tachner.<sup>3</sup> The Office requests Petitioner provide an explanation for Petitioner’s apparent failure to inquire into the status of the patents on an earlier date.

The Office requests Petitioner supply a copy of invoices pertaining to the annual fees for E1 or E2. The invoices are relevant in so far as the invoices may state the invoices apply to “annual” fees for E1 and E2. In other words, the invoices might include information indicating Petitioner should expect to receive invoices for the fees each year.

In addition to the information requested above, the Office requests Petitioner supply any and all other information Petitioner wishes for the Office to consider in the future when determining if the record demonstrates Petitioner’s diligence in inquiring into the status of Petitioner’s patents was consistent with the level of care generally used by reasonable and prudent individuals when handling their most important business.

### Address of Record

The Response is signed by Everett D. Robinson. Mr. Robinson does not appear to be an attorney or agent of record in this case and the address listed in the Response is different than the address of record. A courtesy copy of this decision is being mailed to Mr. Robinson at the address in the Response. However, all future correspondence will be directed solely to the address currently of record until such time as appropriate instructions are received to the contrary.

### Fees

The Response includes a payment of \$4,890. The 3.5 year maintenance fee, the 7.5 year maintenance fee, a \$700 surcharge, and \$400 for the prior request for reconsideration have previously been submitted. As a result, the only fee due with the papers filed December 19, 2011, is the \$400 fee required for the petition under 37 C.F.R. § 1.183. Therefore, the Office has credited \$4,490 (\$4,890 - \$400) back to the credit card used to pay the \$4,890.

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<sup>2</sup> Response, p. 7.

<sup>3</sup> The Office assumes Tachner sent an invoice to Petitioner during July 2004 for the maintenance paid for Atomic-2 on July 7, 2004.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.<sup>4</sup>  
Document Code "PET.OP" should be used if the request is filed electronically.

By mail: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300  
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney  
Steven Brantley at (571) 272-3203.



Charles Steven Brantley  
Senior Petitions Attorney  
Office of Petitions

cc: Everett D. Robinson  
Echelon IP, LLC  
P.O. Box 1047  
American Fork, UT 84003

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<sup>4</sup> General Information concerning EFS Web can be found at <http://www.uspto.gov/patents/process/file/efs/index.jsp>.